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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,465	10/23/2003	Brad L. Noll	1940-031320	7255

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EXAMINER

KRISHNAMURTHY, RAMESH

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,465

Applicant(s)

NOLL ET AL.

Examiner

Ramesh Krishnamurthy

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 32 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 9, 11 - 20, 22 - 25, 28, 30, 32 is/are rejected.
- 7) ☒ Claim(s) 26, 27, 29 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/04(replacement sheets) & 10/23/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3753

This office action is responsive to communications filed 12/14/2005.

Claims 1 – 32 are pending.

1. Applicant's election with traverse of Species A in the reply filed on 12/14/2005 is acknowledged. The traversal is on the ground(s) that a search would be the same for all the species. This argument is not found persuasive because it fails to evince an appreciation that the species claimed are not patentably distinct. That is, the election of species requirement was made on the basis that the claimed species are, in fact, patentably distinct, and not on the basis of how they are searched. Applicant's argument that "they could all be searched in one search" does not render the once considered patentably distinct species now not patentably distinct. Claims 10 and 21 are withdrawn for further consideration as being drawn to a non-elected species.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1 – 9, 11 – 20 and 22 – 32 remain for further consideration.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 9, 11 – 13, 15 – 20, 22 – 25, 28, 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/70246.

The document WO'246 discloses a modular casing or a check valve arrangement that comprises a housing having an inlet end (44) and an outlet end (48) defining a flow channel therebetween, a modular cage (56) removably secured to said

Art Unit: 3753

housing, the modular cage having an interior cavity wherein at least one check valve assembly (72, 74) is removably placed. A fluid seal each (68, 70) in the form of a gasket is positioned at the two ends of the modular cage for sealing the cage within the flow channel the housing. A lug (78) extending outwardly from said housing, the lug defining an orifice (85) adapted to receive a fastener (90). The modular cage defines at least one protrusion (86) having a slot (88) aligned with said orifice of said lug whereby the fastener (90) passes through the slot and the orifice for securing said modular cage to the housing. The modular cage shows a lip near the location where channel (98) is joined to the modular cage in Fig. 11. It is noted that the arrangement disclosed in WO'246 necessarily performs the method recited in claims 25, 28, 30 and 32 in its usual and normal operation.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 3753

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/70246.

The document WO'246 discloses the claimed invention with the exception of explicitly disclosing the first diameter portion of the interior cavity has a diameter that is less than that of the second diameter portion.

The provision of a first diameter portion of the interior cavity having a diameter that is less than that of the second diameter portion is considered to be an obvious design expedient over those features in WO'246 in that it neither provides any new and/or unexpected result nor solves any stated problem.

7. Claims 26, 27, 29 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

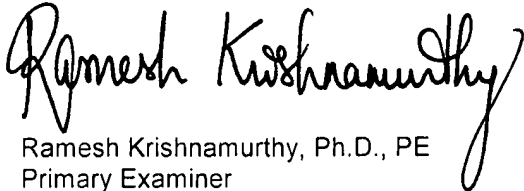
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh Krishnamurthy whose telephone number is (571) 272 – 4914. The examiner can normally be reached on Monday - Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel, can be reached on (571) 272 – 4929. The fax phone number for the organization where this application or proceeding is assigned is (571) 273 – 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 3753

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Ramesh Krishnamurthy". The signature is fluid and cursive, with the first letter of each word being capitalized and prominent.

Ramesh Krishnamurthy, Ph.D., PE
Primary Examiner
Art Unit 3753